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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,947	12/26/2001	Hsuan-Yin Lan-Hargest	12938-003002	8464

26171 7590 03/19/2004

FISH & RICHARDSON P.C.
 1425 K STREET, N.W.
 11TH FLOOR
 WASHINGTON, DC 20005-3500

EXAMINER

ZUCKER, PAUL A

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/025,947	LAN-HARGEST ET AL.	
	Examiner	Art Unit	
	Paul A. Zucker	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26 and 80-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26 and 80-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26 and 80-102 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 February 2004 has been entered. This application is being examined on the basis of Applicants prior election of the specie 7,7-diphenyl-2, 4, 6-heptatrienoic acid.

Current Status

2. This action is responsive to Applicants' amendment of 3 February 2004.
3. Receipt and entry of Applicants' amendment is acknowledged.
4. Applicant's addition of new claim 102 is acknowledged.
5. Claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102 are pending.
6. The rejections under 35 USC § 102 (b) set forth in paragraphs 7 and 8 of the previous Office Action mailed 23 September 2003 are withdrawn in response to Applicants' amendment.

New Rejections

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 80-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 80, drawn to a pharmaceutical composition, recites the limitation "comprising an effective amount of a compound of formula (I)". Claim 80, however, does not recite what disease state is to be treated. It is therefore impossible to determine the meaning of an "an effective amount". Claim 80 and its dependents are therefore rendered indefinite.

Claim Rejections - 35 USC § 102

2. Claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaeger et al (European Journal of Medicinal Chemistry, Structure-activity Relationship Studies of Retinoid Cancer Inhibition, 1993, 28, pages 275-290). Jaeger discloses (Page 278, Table I, bottom, entries 92 and 93) the compounds **92** and **93** which correspond to compounds of instant formula (1) wherein A = substituted and unsubstituted phenyl; Y¹, Y² = a bond; L is a straight chain C₈ hydrocarbon with 4 double bonds in *trans* configuration substituted with methyl groups and X¹, X² = O. Jaeger further discloses (Page 279, Table I, center, entry 120) the compound **120** which corresponds to a compound of instant formula (1) wherein A = C₆ cycloalkenyl; Y¹, Y² = a bond; L is a straight chain C₆ hydrocarbon with 2 double bonds in *trans* configuration substituted with a methyl

group and $X^1, X^2 = O$. Jaeger further discloses (Page 280, Table I, bottom) the use 10^{-8} molar solutions (pharmaceutical compositions) for treating keratinized cell cultures. Jaeger therefore anticipates claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102.

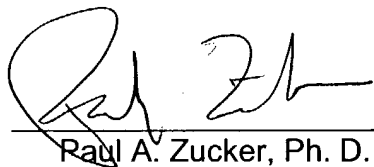
Conclusion

3. Claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102 are pending. Claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Paul Zucker', is positioned above a horizontal line.

Paul A. Zucker, Ph. D.
Patent Examiner
Technology Center 1600